



## UNITED STATES DEPARTMENT OF COMMERCE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/497,123 02/03/00 MESSERLI D 8932-114

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QM22/1026

EXAMINER

PENNIE & EDMONDS LLP  
1667 K STREET NW  
SUITE 1000  
WASHINGTON DC 20006

PELLEGRINO, B.

ART UNIT

PAPER NUMBER

3738

8

DATE MAILED:

10/26/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/497,123	MESSERLI ET AL.	
	Examiner Brian E Pellegrino	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 8/16/01.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1,2,4,7,9,14,15 and 17-19 is/are pending in the application.
  - 4a) Of the above claim(s) 4 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2,7,9,14,15 and 17-19 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

**Attachment(s)**

15) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
16) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	20) <input type="checkbox"/> Other: _____

Art Unit: 3738

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election with traverse of Species J in Paper No. 7 is acknowledged.

The traversal is on the ground(s) that the only difference between the species is in shape. This is not found persuasive because according to the drawings Fig. 9 (Species J) also illustrates channels on the end member. Species I does not show channels. Species I poorly illustrates that the top surface even has teeth. Claim 4 is therefore withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 7.

The requirement is still deemed proper and is therefore made FINAL.

### *Claim Rejections - 35 USC § 102*

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1, 7, 9, 14, 15, 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Biedermann et al. (5702451). Fig. 6 shows an end member with a flat top surface to be inserted into an implant. It can be seen that the end member has a first portion 12 and a second portion 19 and a shoulder exists below the top surface. Biedermann also illustrates (Fig. 7) that the top surface is oval, col. 1, lines 61-64. Fig. 3 teaches a plurality of teeth 15 extending outward and has first and second "channels"

14 from the edge. It can also be construed that the prongs 21 or "teeth" have channels established anterolaterally between the prongs, Attachment A. With respect to claim 17, it can be seen (Fig. 11) that the second portion 12 has a plurality of tabs 15.

Claims 1, 2, 9, 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Rabbe et al. (5776197). Fig. 3 shows an end member 22 having a first portion 35 and a second portion 37. The first portion 35 can be interpreted as a shoulder since it extends beyond the second portion. Rabbe et al. also disclose two channels 47 which are opposite one another on an annular, solid top portion. Additionally, the top surface has a plurality of teeth 120 which are spaced apart from one another, see also Fig. 7.

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, 17, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuslich et al. (6149686) in view of Paul et al. (6143033). Kuslich et al. show (Fig. 10, 19) a spinal end cap having tabs to lock secure the cap in the implant. It can be seen there is a shoulder 59 joining first and second portions. However, Kuslich does not disclose a channel extending from the edge and a plurality of teeth spaced apart on the top surface. Paul et al. show (Fig. 3) the top surface of a spinal implant with a plurality of teeth and channels extending from the edge. It would have been obvious to one of ordinary skill in the art to provide teeth and channels on the top surface of an implant as taught by Paul et al. for the top surface of the Kuslich et al.

Art Unit: 3738

end member of Koros et al. in order to enable the implant to interlock with adjacent vertebrae.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuslich '686 in view of Paul '033 as applied to claim 1 above, and further in view of Camino et al. (6086613). Kuslich as modified by Paul is explained supra. Kuslich discloses the end member is made from hard polyethylene, col. 7, lines 23, 24. However, Kuslich in view of Paul does not disclose the use of an alternative material, such as metal for the end member. Camino et al. teach an end member made of metal, col. 4, lines 43-45. It would have been obvious to one of ordinary skill in the art to substitute metal for the end member as taught by Camino et al. for the Kuslich end member modified by Paul et al. in order to provide enhanced capabilities during x-ray procedures.

#### ***Response to Arguments***

Applicant's arguments filed 3/22/01 have been fully considered but they are not persuasive. In response to the Biedermann reference, the channels as claimed are illustrated in the reference because between the tabs are spaces. Fig. 6 shows a shoulder below the top surface and element 15. Regarding the Rabbe reference, there is clearly a shoulder illustrated in Fig. 3 shown by element 35.

#### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Pellegrino whose telephone number is (703) 306-5899. The examiner can normally be reached on Monday-Thursday from 7:30am to 5pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached at (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-2708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Brian E. Pellegrino

October 23, 2001

*Brian E. Pellegrino*

TC 3700, AU 3738

Primary Examiner



Bruce Snow